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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/158,192 09/21/98 KUBICHAN

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IM62/1006

EXAMINER

TUCKER, P

ART UNIT PAPER NUMBER

1721

DATE MAILED:

*2*  
10/06/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

158192

Applicant(s)

KUBICHAN

Examiner

P. TUCKER

Group Art Unit

1721

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1 - 15 is/are pending in the application.
- Of the above claim(s) 10, 11, 14 and 15 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1 - 9, 12 and 13 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-9, 12, and 13, drawn to an electrochromic composition, classified in class 252, subclass 583.
  - II. Claims 10 and 11, drawn to snow or sportsboards, classified in class 280, subclass 809.
  - III. Claims 14 and 15, drawn to a method of making, classified in class 427, subclass 162.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I or II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product may be made by laminating the protective layer without using a liquid coating.
3. Inventions II and III are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate

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product is deemed to be useful as a thermometer detector, and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Robert Sperry on 9/22/99 a provisional election was made with traverse to prosecute the invention of I, claims 1-9, 12 and 13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10, 11, 14 and 15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 teaches various trade names for the acrylic catalyst and reducer. Since the composition of trade names or Trademarks may change with time, the scope of the subject matter is not clear.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

9. Claims 1, 3, 4, 6 8 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Ribi (5918981).

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Ribi teaches a device which comprises a thermochromic layer on a substrate which can be porous or nonporous, and wherein the substrate may be metal, and an acrylate coating may be used as a protective layer (column 2, line 32 - column 3, line 10 and column 6, line 33-59). The present invention is thus anticipated by Ribi.

10. Claims 1-4, 6, 8, 9, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Shibahashi (4425161).

Shibahashi teaches thermochromic sheets in which the sheets are bonded to the substrate by an adhesive, and which may comprise an acrylic protective coating (column 18, line 36 - column 19, line 51).

11. Claims 1-4, 6, 8, 9, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakasuji et al. (4028118).

Nakasuji teaches thermochromic sheets in which the sheets are bonded to the substrate by an adhesive, and which may comprise an acrylic protective coating (column 16, line 16 - column 17, line 30).

12. Claims 1-4, 6, 8 and 9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kito et al. (5585425).

See example 7.

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13. Claims 1, 4 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Chemical abstracts 93:159126, abstract of Sheng Wu Hau Yu Sheng Wu Wu Li Chin Chan, volume 30, pages 64-67, (1979).

The Sheng Journal teaches a liquid crystal thermochromic later on a support film which is coated with a nitrocellulose protective layer. See end of the office action for attached abstract.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ribí (5918191) and Shibahashi et al. (4425161).

Ribí and Shibahashi are described above. Ribí and Shibahashi differ from the present invention in not specifically teaching the use of fiberglass as a substrate. However, Ribí (column 2, lines 44-48 and Shibahashi (column 19, lines 4-8) teach that composites of substances such as glass and plastic may be used as the substrate for the thermochromic layer. The use of a

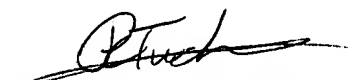
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fiberglass composite would thus be obvious to one of ordinary skill in the art in view of the teachings of Ribí and Shibahashi.

16. Applicants claims such as 3, 12 and 13 are product by process claims, and are properly rejected since only the product is examined in such claims.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Gabrielle Brouillette may be contacted at 703-308-0756. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-305-5408. The **after final** fax no. Is 703-305-3599.

PCT-1906  
September 28, 1999

  
**PHILIP C. TUCKER**  
**ART UNIT 1721**